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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,288	03/20/2008	Yushi Komori	Q97347	6550

23373 7590 03/31/2010  
SUGHRUE MION, PLLC  
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SUITE 800  
WASHINGTON, DC 20037

EXAMINER
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CHIN, HUI H

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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03/31/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

sughrue@sughrue.com  
PPROCESSING@SUGHRUE.COM  
USPTO@SUGHRUE.COM

<b>Office Action Summary</b>	<b>Application No.</b> 10/599,288	<b>Applicant(s)</b> KOMORI, YUSHI	
	<b>Examiner</b> HUI CHIN	<b>Art Unit</b> 1796	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/25/2006</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

2. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-8, drawn to a sheet-shaped adhesive.

Group II, claim(s) 9-12, drawn to a laminate.

3. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature that is commonly shared between the inventions of Group I and II of a sheet-shaped adhesive comprising ethylene-vinyl acetate copolymer and organic peroxide contained therein, wherein the organic peroxide is a peroxy carbonate having a formula of I (tert-butyl peroxide 2-ethylhexyl carbonate) or II, as claimed, is taught by Akira et al. (JP 2003-252658) who teaches a sheet-shaped adhesive comprising ethylene-vinyl acetate copolymer and organic peroxide contained therein (paragraphs [0010] and [0012]), wherein the organic peroxide is a peroxy carbonate of tert-butyl peroxide 2-ethylhexyl carbonate (paragraph [0016]). Akihiko et al. (JP 08-026787) teaches a

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sheet-shaped adhesive comprising ethylene-vinyl acetate copolymer and organic peroxide contained therein (paragraph [0004]), wherein the organic peroxide is a peroxy carbonate of tert-butyl peroxide 2-ethylhexyl carbonate (paragraph [0011]). Toshikazu et al. (JP 2001-310418) teaches a sheet-shaped adhesive comprising ethylene-vinyl acetate copolymer and organic peroxide contained therein (paragraph [0015]), wherein the organic peroxide is a peroxy carbonate of tert-butyl peroxide 2-ethylhexyl carbonate (paragraph [0019]). Yuji et al. (JP 2001-031937) teaches a sheet-shaped adhesive comprising ethylene-vinyl acetate copolymer and organic peroxide contained therein (paragraph [0013]), wherein the organic peroxide is a peroxy carbonate of tert-butyl peroxide 2-ethylhexyl carbonate (paragraph [0017]). Given that each of Akira et al., Akihiko et al., Toshikazu et al., and Yuji et al. teaches the claimed invention, the cited claims fail to define a contribution over the prior art. Therefore, the cited claims fail to constitute a special technical feature and hence lack of unity exists between the cited claims.

4. During a telephone conversation with John Callahan on 15 December 2009 a provisional election was made **without** traverse to prosecute the invention of Group 1, claims 1-8. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

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or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1-8 are rejected under 35 U.S.C. 102(a) as being anticipated by Yuji et al. (JP 2001-031937).

Yuji et al. disclose a plate-shaped bonding material comprising ethylene-vinyl acetate copolymer and organic peroxide such as t-butyl peroxide 2-ethylhexyl carbonate (claim 1, [0017]).

The limitations of claim 2 can be found in Yuji et al. at [0017], where it discloses the 5 or less parts of organic peroxide.

The limitations of claim 3 can be found in Yuji et al. at [0018], where it discloses the 10 or less parts of triallyl isocyanurate.

The limitations of claims 4 and 5 can be found in Yuji et al. at [0017] and [0018], where it discloses the range of peroxide and triallyl isocyanurate.

The limitations of claim 6 can be found in Yuji et al. at [0016], where it discloses the 13 to 35% of vinyl acetate.

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The limitations of claim 7 can be found in Yuji et al. at [0020], where it discloses the calender.

The limitations of claim 8 can be found in Yuji et al. at [0044], where it discloses the pasting which reads on coating.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUI CHIN whose telephone number is (571)270-7350. The examiner can normally be reached on Monday to Friday; 8:00am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Ling-Siu Choi/  
Primary Examiner, Art Unit 1796

/HC/